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THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/625,071

Confirmation No. 5934

Applicants : Hamid Hojaji et al.

Filed : July 22, 2003

TC/A.U. : 3635

Examiner : Jeanette E. Chapman

Docket No. : 50699/10

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Name:	Ruth Artis-McLeod
Signature:	<i>Ruth Artis-McLeod</i>

REPLY TO RESTRICTION REQUIREMENT

Mail Stop AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This reply is responsive to the June 23, 2005 Office Action in the above-referenced U.S. patent application, requiring the election for prosecution of the claims directed to either:

- 1) Specie 1, a foam glass tile with a closed outer skin on at least one side, having a small average pore size and a large density and a high compression strength as described in paragraph [0021] of the present application;
- 2) Specie 2, a foam glass tile having a closed outer skin on at least one side, having an average pore size of 1.0 mm or less...as described in paragraph [0023] of the present application;

- 3) Specie 3, a foam glass tile having an average pore size of .5mm or less
.....as described in paragraph [0024] of the present application; or
- 4) Specie 4, one or more high density foam glass tiles which can be assembled into a building façade as described in paragraph [0025] of the present application.
- Applicants respectfully disagree that these four species of the claimed foam glass tile are patentably distinct and, therefore, traverse the restriction requirement set forth in the June 23, 2005 Office Action.

The June 23, 2005 Office Action required Applicants “to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.” (June 23, 2005 Office Action, at 2). However, in the same Office Action, the Examiner did not provide any *prima facie* showing of patentably distinct inventions by way of an appropriate explanation that the present invention as set forth in the pending claims directed to different species would require a separate classification, a separate status in the art, or a different field of search. See MPEP 803 and 808.02.

Furthermore, claims to be restricted to different species must be mutually exclusive. See MPEP 806.04(f). However, Applicants respectfully submit that Claims 1-25 and 28 directed to Specie 1; Claims 31-56 and 60 directed to Specie 2; Claims 63-82 and 86-87 directed to Specie 3; and Claims 26-27, 29-30, 57-59, 61-62, 83-85 and 88-89 directed to Specie 4 are not necessarily mutually exclusive.

In addition, it is respectfully submitted that even if divided among different applications, the claims respectively directed to Species 1-4 will most likely be assigned to the same group art unit in the U.S. Patent Office and will require the same prior art search. Accordingly, Applicants respectfully submit that keeping the claims directed to these four Species together in one application would not impose a serious burden on the Examiner. Rather, keeping all the pending claims together will simplify the examination work of the U.S. Patent Office by eliminating the need for duplicative search by the same Examiner.

To impose a proper restriction requirement, the inventions must be independent or distinct as claimed, and there must be a serious burden on the Examiner if restriction is required. MPEP 803. It is respectfully submitted that neither of these criteria for imposing a proper restriction requirement has been met by the Examiner as discussed above. In view of the foregoing, Applicants respectfully request that the restriction requirement be withdrawn and that all the pending claims be allowed to be prosecuted together in the present application.

In the event that the restriction requirement is made final by the Examiner, and in order to comply with 37 C.F.R. § 1.143, Applicants provisionally elect, with traverse, Claims 1-25 and 28 directed to Specie 1 for examination in the present

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Reply dated July 7, 2005

application. All of the non-elected claims are withdrawn under the provisions of 37 C.F.R. § 1.142(b) until final disposition of the elected claims.

No fees or extensions of time are believed to be necessary. However, if any fees are due, please debit Deposit Account No. 01-1785. Please acknowledge receipt of this Reply by stamping the enclosed postcard and returning the same.

Respectfully submitted,

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Dated: New York, New York
July 7, 2005

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